

REMARKS

The present application was filed on June 20, 2003 with claims 1 through 21. Claims 1 through 21 are presently pending in the above-identified patent application

In the Office Action, the Examiner rejected claims 1-19 and 21 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter, and rejected claims 1, 20, and 21 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner also rejected claims 1-16, 20, and 21 under 35 U.S.C. §102(b) as being anticipated by Reichmeyer et al. (United States Patent Number 6,286,038), and rejected claims 17-19 under 35 U.S.C. §103(a) as being unpatentable over Reichmeyer et al. in view of Presley (United States Application Publication Number 2003/0105838).

The specification has been amended to correct typographical errors.

Section 101 Rejections

Claims 1-19 and 21 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. In particular, the Examiner asserts that claims 1 and 21 do not have a "useful, concrete or tangible result."

The Supreme Court has stated that the "[t]ransformation and reduction of an article 'to a different state or thing' is the clue to patentability of a process claim." *Gottschalk v. Benson*, 409 U.S. 63, 70, 175 U.S.P.Q. (BNA) 676 (1972). In other words, claims that require some kind of transformation of subject matter, which has been held to include intangible subject matter, such as data or signals, that are representative of or constitute physical activity or objects have been held to comply with Section 101. See, for example, *In re Warmerdam*, 31 U.S.P.Q.2d (BNA) 1754, 1759 n.5 (Fed. Cir. 1994) or *In re Schrader*, 22 F.3d 290, 295, 30 U.S.P.Q.2d (BNA) 1455, 1459 n.12 (Fed. Cir. 1994)

Thus, as expressly set forth in each of the independent claims, the claimed methods or system describe the automatic generation of executable modules associated with

devices and transform information about input configuration elements and input rules to derive output rules and at least one executable module. The executable module is adapted to access an input configuration element and to trigger the output rule(s). This transformation to output rules and at least one executable module provides a useful, concrete and tangible result.

5 Applicants submit that each of the claims 1-21 are in full compliance with 35 U.S.C. §101, and accordingly, respectfully request that the rejection under 35 U.S.C. §101 be withdrawn

Section 112 Rejections

10 Claims 1, 20, and 21 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner asserts that the limitation “determining which of the plurality of configuration elements could be accessed by the one or more input rules” is vague and asks “how does a rule access an element?”

15 Independent claims 1, 20, and 21 have been amended to require “determining which of the plurality of configuration elements could be accessed based on the one or more input rules.” Applicants believe that this amendment clarifies the cited claims and respectfully request that the section 112 rejection be withdrawn.

Independent Claims 1, 20 and 21

20 Independent claims 1, 20, and 21 were rejected under 35 U.S.C. §102(b) as being anticipated by Reichmeyer et al. Regarding claim 1, the Examiner asserts that Reichmeyer discloses generating one or more output rules using at least the accessed information, the accessed configuration elements, and the input rules, wherein an output rule corresponds to one or more input configuration elements (col. 6, lines 31-42); and generating at least one executable module adapted to access at least a given one of the input configuration elements and to trigger 25 one or more of the output rules corresponding to the given input configuration element (col. 10, line 54, to col. 11, line 27)

Applicants note that the present specification teaches that

5            input rules are also part of specifications for a device and comprise, for example, a set of checks or constraints or both that should be performed before or after a configuration element is accessed. The input rules are generally derived from 'domain experts' (typically network specialists). An input rule is usually represented as a set of executable statements.

(Page 2, lines 24-28.)

The present specification teaches that

10            output rules are determined by using the accessed configuration elements, the input rules, and the way the input rule manipulates its accessed configuration elements. Regarding the latter, output rules may be determined to deal with modifications to configuration elements, as explained in more detail below. In an illustrative embodiment, each output rule is generally derived from exactly one input rule and corresponds to the same input configuration element associated with that input rule. Output rules may be derived from multiple input rules, if desired

15            (Page 3, lines 7-14.)

Finally, the present disclosure teaches that

20            an executable module is generated that is adapted to access at least a given one of the input configuration elements and to trigger one or more of the output rules corresponding to the given input configuration element.

(Page 3, lines 15-17 )

Applicants also note that Reichmeyer is directed to generating a configuration file (see, Abstract). Applicants, however, could find *no* disclosure of "input rules," "output rules," and "executable modules," as defined in the context of the present disclosure, in Reichmeyer. In addition, Reichmeyer does *not* disclose or suggest generating an *executable module adapted to access at least a given input configuration element and to trigger one or more of the output rules corresponding to the given input configuration element*. Independent claims 1, 20, and 21 require generating one or more *output rules* using at least the accessed information, the accessed configuration elements, and the *input rules*, wherein an output rule corresponds to one or more input configuration elements; and generating at least one *executable module adapted to access*

*at least a given one of the input configuration elements and to trigger one or more of the output rules corresponding to the given input configuration element.*

Thus, Reichmeyer et al do not disclose or suggest generating one or more output rules using at least the accessed information, the accessed configuration elements, and the input rules, wherein an output rule corresponds to one or more input configuration elements; and generating at least one executable module adapted to access at least a given one of the input configuration elements and to trigger one or more of the output rules corresponding to the given input configuration element, as required by independent claims 1, 20, and 21

Additional Cited References

10 Presley was also cited by the Examiner for its disclosure of performing a circularity check. Applicants note that Presley is directed to a system and method for actively managing an enterprise of configurable components (see, Abstract). Presley does *not*, however, address the issue of generating an executable module adapted to access an input configuration element and to trigger output rules corresponding to the given input configuration element.

15 Thus, Presley does not disclose or suggest generating one or more output rules using at least the accessed information, the accessed configuration elements, and the input rules, wherein an output rule corresponds to one or more input configuration elements; and generating at least one executable module adapted to access at least a given one of the input configuration elements and to trigger one or more of the output rules corresponding to the given input 20 configuration element, as required by independent claims 1, 20, and 21

Dependent Claims 2-19

Dependent claims 2-16 were rejected under 35 U.S.C. §102(b) as being anticipated by Reichmeyer et al., and claims 17-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Reichmeyer et al. in view of Presley.

25 Claims 2-19 are dependent on claim 1 and are therefore patentably distinguished over Reichmeyer et al. and Presley, alone or in combination, because of their dependency from

amended independent claim 1 for the reasons set forth above, as well as other elements these claims add in combination to their base claim.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at  
5 the telephone number indicated below.

The Examiner's attention to this matter is appreciated.

Respectfully submitted,



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